

REMARKS

I. Introduction

In review of the following comments, re-examination and re-consideration of the application, is requested.

II. Prior Art Rejections

On pages (2)-(4) of the Office Action, claims 1 and 3 were rejected under 35 U.S.C. §103(a) as being obvious in view of the combination of Lee et al., U.S. Publication 2007/0031379 (Lee), Peng et al., WO 03/100020 (Peng), Brake et al., “Alpha-factor-directed synthesis and secretion of mature foreign proteins in *Saccharomyces cerevisiae*,” (Brake), Watt et al., U.S. Patent 7,270,969 (Watt) and Osborne et al., “Mutational analysis of a yeast transcriptional terminator,” (Osborne). On page (5) of the Office Action, claim 4 was rejected under 35 U.S.C. §103(a) as being obvious in view of the combination of Lee, Peng, Brake, Lee, Osborne and Kumar et al., “Investigations into the polymorphisms at the ECM38 locus of two widely used *Saccharomyces cerevisiae* S288C strains,” (Kumar). However, on page (5) of the Office Action, claim 5 was indicated as being allowable if rewritten in independent form to include the base claim and any intervening claims. Applicants acknowledge the indication of allowable claim 5.

Applicants respectfully traverse the rejections to claims 1, 3 and 4 for the following reasons.

A. THE CITED REFERENCES CANNOT BE COMBINED IN A MANNER THAT PRODUCES THE CLAIMED INVENTION

As noted for example in MPEP §§ 2143.03 and 2116.01, in order to establish the obviousness of a claimed invention, an examiner must make “a searching comparison of the claimed invention - including all its limitations - with the teaching of the prior art” (see *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)). In addition, “obviousness requires a suggestion of all limitations in a claim” and “to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art” (see *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974) respectively). Moreover, as the Supreme Court recently stated, “there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness.” KSR Int’l v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). This legal authority confirms that, to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art (see, e.g. *In re Wada and Murphy*, Appeal 2007-3733).

Applicants respectfully traverse the outstanding obviousness rejection because a detailed analysis of the Lee, Peng, Brake, Watt, Osborne and Kumar disclosures shows that they fail to teach or suggest all of the elements recited in Applicants’ claims. For example, not one of the references cited by the Examiner teaches or suggests a recombinant expression vector comprising a yeast α-factor secretion signal represented by SEQ ID NO:2 as recited claim 1. While 2007/0031379 teaches a immunoglobulin kappa light chain secretion sequence (see, e.g. paragraphs [0078], [0085] and [0106]), those of skill in this art understand that this is a completely different element than the element recited in Applicants independent claims (i.e. it is a secretion motif that is derived from a different organism, has a different DNA sequence etc. etc.) . Consequently, the Lee, Peng, Brake, Watt, Osborne and Kumar disclosures therefore fail teach all of elements that are expressly recited in claim 1, much less its recited constellation of elements.

Because Lee, Peng, Brake, Watt, Osborne and Kumar fail to teach all of the elements recited in Applicants’ independent claims, these disclosures cannot be combined in a manner that produces the claimed invention. Because the failure of a combination of references to teach or suggest each and every feature of a claim is fatal to an obviousness rejection under 35 U.S.C. § 103, Applicants therefore request a withdrawal of all rejections under 35 U.S.C. §103(a).

Thus, Applicants submit that independent claim 1 is allowable over Lee, Peng, Brake, Watt, Osborne and Kumar. Further, dependent claims 3-5 are submitted to be allowable over Lee, Peng, Brake, Watt, Osborne and Kumar in the same manner, because they are dependent on independent claim 1, and thus contain all the limitations of the independent claim. In addition, dependent claims 2-5 recite additional novel elements not shown by Lee, Peng, Brake, Watt, Osborne and Kumar.

B. REMOVAL OF 2007/0031379 AS PRIOR ART REFERENCE IN ACCORDANCE
WITH 35 U.S.C. §103(c)

While Applicants respectfully traverse the rejections for the reasons noted above, they wish to further take advantage of 35 U.S.C. 103(c). Specifically, the Examiner's rejection under 35 U.S.C. 103(a) is predicated 2007/0031379, a disclosure which qualifies as prior art under 35 U.S.C. 102(e). In this context, both the instant application and US2007/0031379 were, at the time the invention was made, owned by, or subject to an obligation of assignment to Mogam Biotechnology Research Institute. Applicants' therefore request the removal of 2007/0031379 as a prior art reference in accordance with 35 U.S.C. 103(c).

For this additional reason, Applicants respectfully request a withdrawal of the rejections under 35 U.S.C. §103(a).

III. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

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WJW/

By: William J. Wood/
Name: William J. Wood
Reg. No.: 42,236

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